

PATENT**Application # 10/026,307****Attorney Docket # 2000-0480 (1014-221)****REMARKS**

The Examiner is respectfully thanked for the consideration provided to this application. Reconsideration of this application is respectfully requested in light of the foregoing amendments and the following remarks.

Each of claims 15 and 16 has been amended for reasons unrelated to patentability, including at least one of: to explicitly present one or more elements implicit in the claim as originally written when viewed in light of the specification, thereby not narrowing the scope of the claim; to detect infringement more easily; to enlarge the scope of infringement; to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.); to expedite the issuance of a claim of particular current licensing interest; to target the claim to a party currently interested in licensing certain embodiments; to enlarge the royalty base of the claim; to cover a particular product or person in the marketplace; and/or to target the claim to a particular industry.

Claims 15 and 16 are now pending in this application. Each of claims 15 and 16 are in independent form.

The Obviousness Rejections

Claim 15 was rejected under 35 U.S.C. 103(a) as being unpatentable over Baughan (U.S. Patent No. 6,510,210) in view of PacketCable™ Specification and further in view of Chapman (U.S. Patent No. 6,785,301). These rejections are respectfully traversed.

Claim 16 was rejected under 35 U.S.C. 103(a) as being unpatentable over Baughan (U.S. Patent No. 6,510,210) in view of PacketCable™ Specification and further in view of Jinzaki (2002/0124060). These rejections are respectfully traversed.

PATENT**Application # 10/026,307****Attorney Docket # 2000-0480 (1014-221)****A. *Prima Facie* Criteria**

None of the applied portions of the relied upon references, either alone or in combination, establish a *prima facie* case of obviousness. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." See MPEP 2143. Moreover, the USPTO "has the initial duty of supplying the factual basis for its rejection." *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (C.C.P.A. 1967).

B. Missing Claim Limitations

Inter alia, each of independent claims 15 and 16 recite "delivering the CallerID information to a plurality of end devices via a multicast from a network interface device, the multicast comprising CallerID information formatted by the network interface as an audio signal for at least one audio device, the multicast comprising CallerID information formatted by the network interface device as a visual signal for at least one visual device". The applied portions of Baughan do not expressly or inherently teach or suggest "delivering the CallerID information to a plurality of end devices via a multicast from a network interface device, the multicast comprising CallerID information formatted by the network interface as an audio signal for at least one audio device, the multicast comprising CallerID information formatted by the network interface device as a visual signal for at least one visual device".

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the cited references (an assumption that is respectfully traversed), and even if there

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were a reasonable expectation of success in combining or modify the applied portions of the cited references (another assumption that is respectfully traversed), the applied portions of the cited references still do not expressly or inherently teach or suggest every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

C. No Motivation or Suggestion to Combine Applied References

“When determining the patentability of a claimed invention which combines two known elements, the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.” *Akamai Techs. v. Cable & Wireless Internet Servs.*, 344 F.3d 1186, 68 USPQ 2d 1186 (Fed. Cir. 2003) (emphasis added).

According to the Federal Circuit the “mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, 972 F.2d 1260, 23 USPQ 2d 1780, 1783-784 (Fed. Cir. 1992) (quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988)). In that same case, the Federal Circuit further held that it “is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that ‘[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.’” *Id.*, 23 USPQ 2d at 1784.

The present Office Action presents no evidence whatsoever that any of the applied references provide a suggestion or motivation for a combination with any of the other applied references. Instead, regarding the proffered combinations, the present Office Action recites:

1. “[i]n regards to claim 14, Baughan and PacketCable™ disclose the method of multicasting Caller-ID information. Receiving an incoming call over a cable network

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and extracting the Caller-ID information has been rejected in the claim 1 rejection above. (Although claims 1-13 are directed to a device, the device must function according to some method.) Identifying an IP address and an application port number corresponding to an end device has been rejected in the claim 3 rejection above.

Delivering the Caller-ID information to at least one end device has been rejected in the claim 13 rejection above. Baughan discloses in column 5 lines 12-14 that the device is capable of multiple simultaneous transmissions. It would have been obvious to one skilled in the art that the device was capable of multicasting the Caller-ID information across these multiple streams." See, Pages 5 and 6 of Office Action dated 16 August 2005 and incorporated by reference by the present Office Action rejecting subject matter comprised in claims 15 and 16;

2. "[t]herefore it would have been obvious to one of ordinary skill in the art to use FSK signals for extracting the CallerID information." See, Page 3; and
3. [i]n regards to claim 15, Baughan and PacketCable™ do not disclose caching both the IP address and Fully Qualified Domain Name (FQDN). It is however well known in the art to use a Domain Name System (DNS) to translate an IP address into FQDN or vice versa, as evidenced by Jinzaki (2002/0124060). Once the DNS replies the requesting node has both the IP and FQDN stored in cache.

Thus, the present Office Action falls to provide any evidence that the prior art provides any suggestion or motivation to combine the applied references. Accordingly, the combination of Matsushita with Amer and/or Dodley is impermissible.

D. Obviousness Summary

Thus, there is no motivation or suggestion to combine the relied upon references to arrive at the claimed subject matter and even if combinable or modifiable, the applied portions of the relied upon references do not expressly or inherently teach or suggest every limitation of the

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claims.

It is respectfully noted that because the Office Action fails to set forth sufficient facts to provide a *prima facie* basis for the rejections, any future rejection based on the applied reference will necessarily be factually based on an entirely different portion of that reference, and thus will be legally defined as a "new grounds of rejection." Consequently, any Office Action containing such rejection can not properly be made final. *See In re Wiechert*, 152 U.S.P.Q. 247, 251-52 (C.C.P.A. 1967) (defining "new ground of rejection" and requiring that "when a rejection is factually based on an entirely different portion of an existing reference the appellant should be afforded an opportunity to make a showing of unobviousness vis-a-vis such portion of the reference"), and *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (C.C.P.A. 1967) (the USPTO "has the initial duty of supplying the factual basis for its rejection").

Allowable Subject Matter

A potential statement of reasons for the indication of allowable subject matter is:

"none of the references of record alone or in combination disclose or suggest the combination of limitations found in the independent claims. Namely, claims 15-16 are allowable because none of the references of record alone or in combination disclose or suggest 'delivering the CallerID information to a plurality of end devices via a multicast from a network interface device, the multicast comprising CallerID information formatted by the network interface as an audio signal for at least one audio device, the multicast comprising CallerID information formatted by the network interface device as a visual signal for at least one visual device'".

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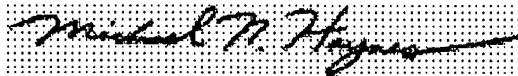
CONCLUSION

It is respectfully submitted that, in view of the foregoing amendments and remarks, the application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

Michael Haynes PLC

A handwritten signature in black ink, appearing to read "Michael N. Haynes", is written over a rectangular area with a light gray dot grid background.

Date: 6 January 2006

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